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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/615,721

07/08/2003

Howard W. Lutnick

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ROPES & GRAY LLP
PATENT DOCKETING 39/361
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EXAMINER

ZECHER, MICHAEL R

ART UNIT

PAPER NUMBER

3691

MAIL DATE

DELIVERY MODE

09/19/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/615,721

Applicant(s)

LUTNICK ET AL.

Examiner

Michael R. Zecher

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-97 is/are pending in the application.
- 4a) Of the above claim(s) 1-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 52-97 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/8/2003, 4/16/2007.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The preliminary amendment received on March 27, 2007, has been acknowledged. The following is a non-final, first Office action on the merits. Claims 1-51 have been cancelled. Claims 52-97 are pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 52-97** are rejected under 35 U.S.C. 102(b) as being anticipated by Kossovsky et al. (U.S. 2002/0004775).

As per claim 52, Kossovsky et al. teaches a method comprising:

capturing intellectual property asset data for a group of companies (See paragraph 10, which discusses using information about an intellectual property asset and data from publicly traded companies);

identifying a plurality of companies from the group of companies bases at least on the intellectual property asset data (See paragraph 109, which discusses identifying the sector and narrowly focused market segments);

capturing market data for the plurality of companies (See paragraph 93, which discusses downloading financial market data);

calculating an intellectual property index based at least on the market data for the plurality of companies (See paragraph 11, which discusses an index of market value of intellectual property belonging to a technology classification); and

updating the intellectual property index periodically (See paragraph 148, which discusses updating suggested prices of all units of patent pertinent to each Securitized Asset).

As per claim 53, Kossovsky et al. teaches wherein the group of companies comprises a plurality of companies in substantially the same industry (See paragraphs 45 & 85, which discusses assigning a sector; and, furthermore, defining a set of major commercial sectors).

As per claim 54, Kossovsky et al. teaches wherein the group of companies comprises a plurality of companies having a particular market capitalization (See paragraphs 60 & 87, which discusses selecting a company based on capitalization; and, furthermore, providing an example of a defined market capitalization).

As per claim 55, Kossovsky et al. teaches wherein the plurality of companies are identified based at least on a value associated with an intellectual property asset portfolio for each of the plurality of companies (See claim 4, which discusses intellectual property valuation in terms of enterprise value of companies in the same technology classification as the intellectual property asset).

As per claim 56, Kossovsky et al. teaches wherein each of the intellectual property asset portfolios comprises at least one patent (See paragraph 44, which discusses how the portfolio includes at least one patent) and wherein the value

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associated with each portfolio is based at least on a number of citations to the at least one patent by a national patent office (See figure 18A, which illustrate published description, proven applications, potential applications, etc.; it is inherent that these application will include relevant citations).

As per claim 57, Kossovsky et al. teaches wherein each of the intellectual property asset portfolios comprises at least one patent (See paragraph 44, which discusses how the portfolio includes at least one patent) and wherein the value associated with each portfolio is based at least on a number of patents issued to the company by a national patent office (See figure 18A & paragraph 132, which illustrates and discusses country issued, if the application is pending, etc.; and, furthermore, call options in the context of issued patents).

As per claim 58, Kossovsky et al. teaches wherein each of the intellectual property asset portfolios comprises at least one patent (See paragraph 44, which discusses how the portfolio includes at least one patent) and wherein the value associated with each portfolio is based at least on the age of the at least one patent (See paragraphs 94, which discusses remaining patent term).

As per claim 59, Kossovsky et al. teaches wherein each of the intellectual property asset portfolio comprises at least one patent (See paragraph 44, which discusses how the portfolio includes at least one patent) and wherein the value associated with each portfolio is based at least on litigation results associated with the at least one patent (See figure 18B, which illustrates litigation history and pending litigation).

As per claim 60, Kossovsky et al. teaches wherein the value associated with an intellectual property asset portfolio is determined based on at least one of licensing contracts and revenues (See figure 18D & paragraph 10, which illustrates and discusses details of a licensing offer, including a specified licensing term).

As per claim 61, Kossovsky et al. teaches wherein the market data comprises a stock price for each of the plurality of companies (See paragraph 80, which discusses the price of an underlying stock).

As per claim 62, Kossovsky et al. teaches receiving a plurality of orders for at least one derivative financial instrument that comprises at least one term associated with the intellectual property index (See paragraph 199, which discusses receiving traditional purchase orders for intellectual property assets) and executing a trade for the at least one derivative financial instrument (See paragraphs 128 & 136, which discusses options traded between other sellers and buyers/parties).

As per claim 63, Kossovsky et al. teaches wherein the at least one derivative financial instrument comprises one of an option contract and a futures contract (See paragraphs 129 & 130, which discusses the contractual right to purchase technology from its owner at a predetermined price before a set expiration date).

As per claim 64, Kossovsky et al. teaches wherein the at least one term associated with the intellectual property index comprises a strike price (See paragraph 80, which discusses an option strike, or exercise price).

As per claim 65, Kossovsky et al. teaches a method comprising:

capturing market data for a plurality of companies (See paragraph 93, which discusses downloading financial market data), each of the plurality of companies identified from a group of companies based at least on intellectual property asset data for the group of companies (See paragraphs 10 & 109, which discusses using information about an intellectual property asset and data from publicly traded companies; and, furthermore, discusses identifying the sector and narrowly focused market segments);

calculating an intellectual property index based at least on the market data for the plurality of companies (See paragraph 11, which discusses an index of market value of intellectual property belonging to a technology classification);

receiving a plurality of order for at least one derivative financial instrument that comprises at least one term associated with the intellectual property index (See paragraph 199, which discusses receiving traditional purchase orders for intellectual property assets); and

executing a trade for the at least one derivative financial instrument (See paragraphs 128 & 136, which discusses options traded between other sellers and buyers/parties).

Claims 66-74 recite equivalent limitations to claims 53-61, respectively, and are therefore rejected using the same art and rationale as set forth above.

As per claim 75, Kossovsky et al. teaches a system comprising at least one computing device having software associated therewith that when executes performs a

method comprising (See figure 1, 2A, & 2B, which illustrates a computer system and hardware/software structures):

capturing intellectual property asset data for a group of companies (See paragraph 10, which discusses using information about an intellectual property asset and data from publicly traded companies);

identifying a plurality of companies from the group of companies bases at least on the intellectual property asset data (See paragraph 109, which discusses identifying the sector and narrowly focused market segments);

capturing market data for the plurality of companies (See paragraph 93, which discusses downloading financial market data);

calculating an intellectual property index based at least on the market data for the plurality of companies (See paragraph 11, which discusses an index of market value of intellectual property belonging to a technology classification); and

updating the intellectual property index periodically (See paragraph 148, which discusses updating suggested prices of all units of patent pertinent to each Securitized Asset).

Claims 76-87 recite equivalent limitations to claims 53-64, respectively, and are therefore rejected using the same art and rationale.

As per claim 88, Kossovsky et al. teaches a system comprising at least one computing device having software associated therewith that when executes performs a method comprising (See figure 1, 2A, & 2B, which illustrates a computer system and hardware/software structures):

capturing market data for a plurality of companies (See paragraph 93, which discusses downloading financial market data), each of the plurality of companies identified from a group of companies based at least on intellectual property asset data for the group of companies (See paragraphs 10 & 109, which discusses using information about an intellectual property asset and data from publicly traded companies; and, furthermore, discusses identifying the sector and narrowly focused market segments);

calculating an intellectual property index based at least on the market data for the plurality of companies (See paragraph 11, which discusses an index of market value of intellectual property belonging to a technology classification);

receiving a plurality of order for at least one derivative financial instrument that comprises at least one term associated with the intellectual property index (See paragraph 199, which discusses receiving traditional purchase orders for intellectual property assets); and

executing a trade for the at least one derivative financial instrument (See paragraphs 128 & 136, which discusses options traded between other sellers and buyers/parties).

Claims 89-97 recite equivalent limitations to claims 53-61, respectively, and are therefore rejected using the same art and rationale as set forth above.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bowen et al. (U.S. 2005/0119962) discloses a method and system for securitizing contracts valued on an index.

Alcaly et al. (U.S. 2002/0007329) discloses a method and system for generating an index of investment returns.

Lange (U.S. 6,321,212) discloses financial products having a demand-based, adjustable return, and trading exchange therefor

Kossovsky et al. (U.S. 2002/0002524) discloses an online patent and license exchange.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael R. Zecher whose telephone number is 571-270-3032. The examiner can normally be reached on M-F 7:30-5:00 alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MRZ

A handwritten signature in black ink, appearing to read 'H. M. Kazimi', with a long horizontal stroke extending to the right.

HANI M. KAZIMI
PRIMARY EXAMINER